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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

WILLIAM T. GRAHAM AND GRAHAM PLOW INC.,
Petitioners,

v.

JOHN DEERE COMPANY OF KANSAS CITY,
AND DEERE & COMPANY,
Respondents.

BRIEF AMICUS CURIAE IN SUPPORT OF 35 USC 103

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CONSTITUTIONAL PROVISION RELIED UPON

Article 1, Section 8, clause 8:

The Congress shall have Power . . .

To promote the progress of Science and useful Arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries;

STATUTORY PROVISIONS RELIED UPON

Title 35 USC

§101 Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§102 Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless — (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent . . . [such prior knowledge of others in § 103 being referred to as "prior art"].

§103 Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

RULES RELIED UPON

Federal Rules of Civil Procedure
Rule 52 Finding by the Court

(a) *Effect.* In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58 . . . Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the creditability of the witnesses.

CONSENT OF THE PARTIES TO THE FILING OF THIS BRIEF

The undersigned orally requested of counsel for the parties to this case, their consent to the filing of this brief.

Their replies indicating that they have no objection to the filing of this brief are reproduced as the next two pages of this instrument.

Wherefore the undersigned asks that the Court accept this brief for filing, and give it due consideration.

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February 22, 1965

AIR MAIL
Professor Ernest Goldstein
University of Texas Law School
Austin, Texas

In re: No. 580 in the Supreme Court of the United States; William T. Graham and Graham Plow, Inc., Petitioners, vs. John Deere Company of Kansas City and Deere & Company, Respondents

Dear Professor Goldstein:

In behalf of the petitioners in the above cause, we hereby consent to your filing an amicus curiae brief in behalf of the University of Texas Law School.

Yours very truly,

FISHBURN & GOLD

By: /s/ CLAUDE A. FISHBURN

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Dear Professor Goldstein:

In behalf of the respondents in the above cause, we hereby consent to your filing an amicus curiae brief in the Supreme Court.

Yours very truly,

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No. 580

In The

Supreme Court of the United States

October Term, 1964

William T. Graham and Graham Plow Inc.,
Petitioners,

v.

John Deere Company of Kansas City,
and Deere & Company,
Respondents.

BRIEF AMICUS CURIAE IN SUPPORT OF 35 USC 103

1. Interest of the Amici and Importance of this case

The undersigned have no interest, pecuniary or otherwise, in the results in this case. This brief is not presented in support of any result as to the particular patent-in-suit.

Neither the patent in suit nor the size of the market for the plows is important enough to justify outsiders such as the undersigned to write and file a brief *amicus curiae.*

Rather, this case incites the time, trouble and expense of an *amicus* brief,

(1) because some writings by some Justices of this Court and the opinion by the Court of Appeals in this case, appear

to put the practical operating life of the patent system at stake, and to put the whole socio-economic functioning of the entire patent system at issue; and

(2) because a review of the briefs heretofore filed in both this litigation and prior litigation of the same patent, make it clear that the parties have not fully exposed to the Courts, the socio-economic forces of the patent system or the legal role of Section 103 of Title 35 in those forces.

Further, the Courts of the United States have split dramatically for the dozen years since the Congress in 1952 enacted 35 USC 103 — the jugular vein of the entire patent system. Some courts have in practical effect repealed the entirety of Title 35 USC by their abuse of § 103 thereof.

For example: Leading up to the present case, the Court of Appeals for the Eighth Circuit had held some 22 consecutive patents invalid. And the Third Circuit record now stands at 32 *in*valid out of the last 33 before it, with only two dissents. In this Court we find that some Justices have found as a general rule unpatentable subject matter in the patent cases taken by this Court in the past quarter century.

So strong has been the judicial attack of some Courts upon the patent system as to bring Mr. Justice Jackson to observe:

> ". . . the only patent that is valid is one which this Court has not been able to get its hands on." *Jungersen* v. *Ostby and Barton Company* et al (Supreme Court 1949) 335 US 560, 80 USPQ 32 at 36.

Thus is the reason for this *amicus* brief made apparent — the major degree of *de facto* judicial repeal of the patent system to date raises the fear in us as students of anti-trust, constitutional and patent law, that such repeal might be rendered complete by this Court if this Court fails to uphold specifically and directly 35 U.S. 103.

In the case before the Court, there stands at issue the very life of the patent system as a socio-economic force.

That socio-economic force is as important as any issue ever to come before this Court.

The issue commands of the Court an understanding, perception and true craftsman's attention to the Court's expression of opinion — *the more importantly so if the patent is viewed as invalid* than if viewed as valid.

2. If the patent system is to function to induce investment of private capital in research, patents must protect the innovations of practical stature produced by ordinary men working with investors dollars.

Our nation's economy is built in large part upon the results of a vigorous and aggressive Research and Development effort (often called "R and D"). No individual inventive genius no matter how dedicated can finance the expenses of modern research. Finance of R and D must be induced from all sources — individual investors, banks and other lending agencies, corporate research budgets, etc.

Those R & D dollars **must** be recovered out of the results of the research and development investment, else no bank loan committee or business manager could afford the investment of capital in such expensive endeavor. Patent protection is an incentive to R & D investment.

Example: It is common for businesses to hire an ordinary graduate engineer or chemist, and pay his salary, his office space, his equipment and materials costs, and all other costs of his experiments and tests, while he tests each of thousands of chemicals and/or materials in hopes of finding one what will, let us say, kill the lamprey parasite that

nearly destroyed the entire fishing industry of the Great Lakes.

The chemicals he tests are all known poisons, but he must (1) learn the life cycle of the lamprey as an aid to testing when to apply his poison, (2) figure out which poisons will in proper time disintegrate so as not to build up a poison level in the lakes, (3) determine which poison to apply in natural surroundings and (4) calculate the concentrations thereof and (5) establish the techniques of applying it to rivers and streams, whereby the lamprey may be killed and game and food fish preserved.

In such an endeavor this ordinary man may spend $100,000, or $300,000 or more over several years, and come up with nothing; or he may spend such sums and come up with a concentration of a well known poison that is also well known for use in killing lake-dwelling rodents.

Query: Is his *discovery* (the Constitution's word) after dozens upon dozens of expensive trials and errors, of the right technique for use of this prior known poison in the control of the lamprey parasite, a "progress of the science and the useful arts" which the Constitution seeks to protect — even though by hindsight we can note the fact that the poison is well known for lake applications against rodents as proof that the invention has no stature?

If corporate R and D budgets are to continue to be justified, then inventions and discoveries of the stature that are produced by ordinary men spending ordinary research dollars *without flashes of genius,* must be protected by the patent law.

3. Judicial decisions prior to 35 USC 103 were contradictory and incited Congressional enactment of § 103.

Some judges, seemingly oblivious of the role of the patent system as an inducement of *capital investment* in R & D have taken the position that almost every patent before them is invalid for failure to meet the "strict" or "stringent requirements of invention required by the constitution" or required by the opinions of the Supreme Court.

For example, counting each judge's individual vote, we have 94 out of the last 99 judicial votes in the Third Circuit, to be for *in*validity.

While some flimsy patents were, no doubt, among those before the Court, we must also assume that there were many sound patents, and that the lawyers were taking many properly arguable cases to the Courts of Appeals while settling prior to appeal the totally unjustified cases.

By contrast other Courts (e.g. the Court of Appeals for the Tenth Circuit for the last seven years) have sustained over 70% of the patents before them as defining invention of patentable stature.

That this startling variance in performance should have continued for so many years raises doubts as to practical functioning of the judicial system. More importantly—

It renders clear the complete impossibility of any Court applying a law "standard of invention" subjectively, and points up the need for the factual requirement for patentability of Section 103. See the Appendix A hereto for a full explanation of why the subjective "standard of invention" is impossible of uniform understanding.

Prior to 1952 there was no statutory effort at a statement of what level or stature of invention was patentable. The

Courts played with that isue with as varied results as the statistics quoted above suggest.

Then the Congress acted, enacting 35 USC 103 to become effective January 1, 1953.

4. Section 103 is not a codification of any prior law, but is an original expression of a unique requirement for patentability.

Some writers to the contrary notwithstanding, it is *inherently impossible* that Section 103 codified exactly *any* prior decision that did not use the same words as the statute. For there are in our language no synonyms of 100% identical meaning.

True it must be, that the drafters who selected the words of Section 103 had some idea in mind, as one they wished to establish as a norm. Apparently they had in mind the opinion in *Hotchkiss* v. *Greenwood* (Supreme Court 1850) 52 US 248, but they were not following *Cuno Engineering Corp.* v. *Automatic Devices Corp.* (Supreme Court 1941) 314 US 84, 51 USPQ 272.

But whatever previous idea the drafters had in mind is of no consequence; the words used in Title 35 USC 103 are positive, clear and unequivocal in their statement of their own requirement — a unique requirement never before expressed in jurisprudence.

It is reasonable to assume that the drafters wanted something more than a highly subjective "standard of invention". It is more than likely that the drafters intended to establish a requirement for patentability that would serve as a basis for a finding of fact of patentability which would then be subject to the operation of Rule 52(a) of the Federal Rules

of Civil Procedure, thus narrowing the area of appellate review.

The pre1953 history is pertinent only to illuminate the factors impelling Congressional action.

No pre1953 opinion was stated to be codified so none were codified except to the extent consistent with the naked words of § 103 — and as to *that* the naked words of 103 must stand independently.

Fair treatment of the Congressional effort calls for the giving of full meaning to the words of § 103 without distortion by prior divergent judicial writings.

To do otherwise is to deny Congress the power to legislate along lines close to but different from prior precedents.

5. Section 103 provides a factual requirement for patentability subject to the operation of Rule 52(a) of the Rules of Civil Procedure.

The Constitutional word of interest is "discovery" — a word clearly connoting (as did also the 1789 word "invention" *not* used in the Constitution) a finding-out, whether or not others had previously found-out the same thing.

Congress has decided (35 USC 102) that however original an inventor's work, what he finds-out or discovers is not patentable if others had previously discovered or found-out the same thing.

Congress also decided as evidenced by the plain words of § 103, to assume that a mythical man of "ordinary skill" nevertheless knows the sum total of mankind's knowledge — the "prior art". On that assumption Congress said that whatever an inventor finds out or discovers is not patentable,

> "if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

Whether a discovery is patentable is under Section 103 not related to any "standard of invention" as it was by prior case law, now patentability is determined solely by the measure "obvious to a person having ordinary skill in the art" after consideration of all the "prior art".

"Obviousness" is a fact.

It cannot be otherwise.

The judgments of the Patent Code's mythical ordinary man must be as subject to Rule 52(a) as those of the reasonably prudent man in negligence cases.

To say otherwise would be to distort what Congress determined to be the public policy, in correcting the prior widely variant court views.

6. Section 103 as it nakedly reads, is constitutional.

From the foregoing it is quite clear: The constitutional word "discovery" authorizes Congress if it so elects to protect every original "finding out" of any stature, whether or not previously known to others or obvious from what others have done.

The fact finding that this would promote the useful arts was properly and accurately made by the Constitutional Congress 175 years ago, and this fact is still true today.

The Congress's restriction of patent protection to only those discoveries not obvious to the man of ordinary skill

is clearly narrower than and within its Constitutional authority.

7. The Congressional Policy of 35 USC 103 is sound social policy.

Those things which are already known to and used or published by others are not patentable. 35 USC 102.

This is good social policy because: To permit a new inventor of devices already in the public domain to receive a patent right to preclude others from using that invention, is to permit one man *to take from* the public domain into his private domain.

Similarly, if you ask a man skilled in the art to produce a given new device, and he can do so almost immediately without major investment of research and development money, such a device is also in the *present public availability* and needs no incentive to produce it however new it is.

Such a device as the man of ordinary skill can, even though new, readily provide on request, is obvious to him and not patentable under 35 USC 103. And this too is sound social policy.

But if when requested to produce a given device, the man of skill in the art is unable to do so, but rather needs significant amounts of time, tests, experiments and money to produce it, then that device

(1) is *not presently* within the public availability or the public domain.

(2) is not obvious.

(3) *is* patentable under § 103.

But since that patentable device is not presently within the public availability, the granting of a patent right to preclude others from using it *takes nothing from* the public domain, but rather secures to the inventor for a limited time only *the new device given by him to the public for the first time.*

Thus the obviousness requirement of § 103 is seen to draw the line squarely upon the public policy line without special attention to the private right of the inventor.

The obviousness requirement secures the incentive-producing patent only as to devices not then enjoying ready public availability.

8. This Court should find that the Congressional requirement of §103 is law superseding all prior law.

As aforesaid judges following the legal "standard of invention" rule have produced erratic results, sometimes deleterious to the socio-economic incentives of the patent system.

The "standard of invention" rule leaves to Courts the socio-economic issue of what *should* be patentable whereas public good is better served if the judiciary determines what is patentable according to the standard established by Congress.

The only way to give Congress's effort a fair try is to try it — and encourage other courts to try to apply Section 103 as Congress wrote it, as a factual requirement of nonobviousness to the exclusion of any court-determined "standard of invention".

Any determination of the law as being other than as Congress wrote it, in this case is not only a distortion of ap-

parent Congressional intent, but also denies to Congress the power granted it by the Constitution to set a patent policy.

9. Conclusion, and suggested action by the Court.

Since a number of the courts the country over, including the Eighth Circuit Court of Appeals in this case, have distorted the requirement of nonobviousness into the pre-§ 103 court-made "flash of genius standard of invention", it is imperative that this Court bring order out of chaos by clearly announcing, without regard to the patent here in suit, that:

(1) There is no longer a "standard of invention" for patentability.

(2) 35 USC 103 is constitutional and clearly requires only subject matter not obvious to the man of ordinary skill in the art.

(3) All court language similar to but variant from the statute's requirement is verbiage not pertinent to the statute's test.

(4) That factual requirement of nonobvious subject matter, is an issue within the operation of Rule 52(a).

Re Appendix

The Honorable Giles Rich ranks as a preeminent authority in the field of patent law. He has been a teacher of law at the Columbia Law School and a distinguished practitioner of patent law for more than twenty-five years. Now he is a Judge of the Court of Customs and Patent Appeals.

Judge Rich has been a student of Section 103 from the time when he helped to draft it. On the bench he has had unequalled and extensive experience in applying Section 103 to varied and myriad situations.

In this specialized area of law and socio-economics, it is fortunate that there is available to this Court the views of Judge Rich written before this case came to this Court.

Accordingly we attach hereto as Appendix A, and respectfully urge detailed study and consideration of, "The Vague Concept of Invention as Replaced by Sec. 103 of the 1952 Patent Act", delivered by Judge Rich in June 1964 on the occasion of his accepting the Kettering Award from the Patent Trademark and Copyright Foundation of the George Washington University.

Respectfully,

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Austin, Texas

CERTIFICATE OF SERVICE

The undersigned hereby certifies that copies of the foregoing have been mailed regular first class mail to counsel for the parties Messrs. Claude A. Fishburn and Orville O. Gold, 1217 Commerce Trust Building, Kansas City 6, Missouri, Counsel for Petitioners, and Mr. S. Tom Morris, Gibson, Ochsner, Harlan Kinney & Morris, 630 Amarillo Building, Amarillo, Texas, Counsel for Respondents, and Mr. Thomas E. Scofield, 1325 Realto Building, Kansas City 6, Missouri.

.....

APPENDIX A

THE VAGUE CONCEPT OF "INVENTION" AS REPLACED BY SEC. 103 OF THE 1952 PATENT ACT

By Judge Giles Rich,

Court of Customs and Patent Appeals

A speech delivered in June 1964 upon the occasion of Judge Rich's receiving the Kettering Award of the Patent, Trademark and Copyright Foundation of the George Washington University.

THE VAGUE CONCEPT OF "INVENTION" AS REPLACED BY SEC. 103 OF THE 1952 PATENT ACT

By GILES S. RICH *

I believe in incentive systems. Over 20 years ago a prize competition lured me into some intense study and writing[1] which, through a traceable chain of events, has led to my being here tonight.

I did not win the prize. Neither did the other contestants, save one.[2] But they all contributed something. That is the way incentive systems work. They bring out all kinds of efforts, excellent, good, mediocre, indifferent, and bad. But the *system* brings forth the effort. Society benefits from the good and mediocre, as well as the excellent, efforts. The bad efforts don't hurt it any. They may even prevent others from making mistakes if they are made known.

The patent and copyright laws create such incentive systems. The copyright laws provide an incentive which brings out the greatest works of literature as well as a lot of trash. The patent system works in a similar way. But you can't get cream without producing milk and, anyway, it is the milk that society lives on.

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* Associate Judge, United States Court of Customs and Patent Appeals.

This article is the speech delivered by the author on June 18, 1964 in accepting the Kettering Award for 1963 from The Patent, Trademark, and Copyright Research Institute of The George Washington University. It was previously published in the Institute's publication "IDEA" Conference Number 1964, page 136.

In the present version the author has made a few minor corrections and revisions.

[1] The Linthicum Foundation Competition, 1941, Dean John H. Wigmore, Northwestern University Law School, Chairman. The writer's contribution was published in five installments in the Journal of the Patent Office Society, Vol. 24, pp. 85, 159, 241, 328, and 422, commencing Feb. 1942.

[2] The winner was Laurence I. Wood whose paper was published in book form, 1942, by Commerce Clearing House, Inc., under the title *Patents* and *Antitrust Law*. He is presently a vice president and general cousel of General Electric Company.

I don't suppose you will be surprised if I talk about the patent system. The aspect of it I will talk about is the one I think causes the most trouble, the clarification of which I therefore believe would do the most good.

As groundwork I will first state an axiomatic but too-little-thought-of principle. A monopoly merely gives rise to *power* which can be put to either good or bad uses. Hence, in the case of monopolies created by government grant, which is all patents are so far as the rights they create are concerned,[3] we have to distinguish between good and bad monopolies.

I will take two well-known examples from history. First, the bad monopoly. Queen Elizabeth granted to one Darcy, a member of her court, a monopoly of playing-cards for 21 years so that he could make some money. But playing-cards were old and well-known and others were making a living from making and selling them in England. This monopoly, which was by Royal Letters Patent, therefore took from

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[3] Dean Wigmore, n. 1, in his foreword to the Wood book, n. e., said:

> * * * I take the opportunity to intrude my personal opinion, that neither Courts nor treatice-writers have been radical enough in defending the legitimacy of the "monopoly" in a patent, as distinquished from the ordinary trade-monopoly. Is it not a fact that every property-right we have a "monopoly"? The right to our house or our automobile is simply a right to keep anyone else from entering or using it without our consent; and is that not a monopoly?
>
> * * * *
>
> Of course patent-rights can be so *used* as to merit the distrust attaching to a monopoly, — by contracts fixing prices, by tying agreements, by pools and the like. But so can gold-mines and all the necessities of life by bargains be used monopolistically; yet no one blames the mine-owning right itself or the food-ownership right itself; the blame is directed to the use of it.
>
> And so I for one regard it as unfortunate that courts and treatise-writers have not stood up more boldly for the fundamental rightness of the patent right itself. I say "for one", because I do not recall reading anywhere an adequate defence of the theory of the patent-right.

the public a freedom in business which it had long enjoyed before the patent; and it was bad.[4]

In Venice in 1594 the Doge, on behalf of the government granted to the great Galileo a "privilege," which was the Venetian name for a patent, on a machine which he had *invented* "for raising water and irrigating land with small expense and great convenience," on the condition that it had never before been thought of or made by others. Galileo made a couple of significant remarks in his petition for the privilege. He said, "it not being fit that this invention, which is my own, discovered by me with great labor and expense, be made the common property of everyone;" and also, that if he were granted the privilege, "I shall the more attentively apply myself to new inventions for universal benefit." In short, he was not inclined to divulge his invention only to have it copied; but if the government would give him some reasonable protection he would not only divulge it and build it but might even apply himself to making some more inventions. Deeming this to be a *good* use to which to put a limited monopoly, the Council voted to grant him a "privilege" or patent of monopoly for 21 years.[5]

The Venetians were accustomed to doing this, having granted about 1600 "privileges" in the 15th and 16th centuries.[6]

In the 17th century the English, in 1624, enacted a statute[7] abolishing and prohibiting future monopolies of

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[4] *Darcy* v. *Allin*, 11 Co. Rep. 846; I W. P. C. I. See *Monopolies and Patents* by Harold G. Fox, U. of Toronto Press, 1947, p. 318. The case also has the popular title "The Case of Monopolies."

[5] Journal of the Patent Office Society, Centennial Number, "History of the Patent Office," July 1936, Vol. 18, p. 23.

[6] Id. Most of the privileges were for copyrights but a small percentage were for inventions.

[7] The Statute of Monopolies, May 25, 1624, 21 Jac. I, c. 3. For its history see Fox, supra, n. 4, Chap. IX, pp. 113-126.

the bad Darcy sort and authorizing the continuing grant of Letters Patent for new inventions within the realm, a practice which has continue to this day.

The founding fathers came to America from the mother country, bringing with them knowledge of this practice of granting monopolies. In the nearly 150 years of the colonial period preceding the Federal Constitution, the colonies and then the States granted numerous patents for new inventions as well as monopolies to encourage the founding of new industries, including, as the English did, encouragement of setting up in America industries already practiced abroad.[8]

It is not surprising that, when it came to the writing of a Constitution, provision should be incorporated, with no controversy at all, for Congress to make laws for the granting of patents to inventors, or that George Washington should urge its speedy enactment, or that the very first Congress should enact our first Patent Act of 1790.[9]

Then began our patent system. One might describe it as a great experiment which goes on continuously, getting more complex all the time, in which this Institute is playing, for the first time, a vital role in finding out how the system as a whole actually works, as an aid to preserving its basic principles and saving the obvious good that is in it.

In this experiment, which involves a mixture of economics, law, technology, and psychology, we still have the centuries-old problem of monopoly power being utilized for socially good and socially bad ends and of deciding which is which.

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[8] See JPOS, supra, n. 5, pp. 35-58.

[9] Id. pp. 55-62.

The greedy nature of some men is such that there are always pressures toward the creation of bad monopolies. Undue preoccupation with countering this pressure, however, has quite blurred the vision of many well-intentioned but not too well-informed people to the good uses monopoly can be put to and to the good that monopoly power can do, properly channeled and not so proscribed as to lose its effective power.

Paradoxically, in the working of the patent system, monopoly often promotes competition. Numerous instances are all around us, wherever two products serving the same general purpose have achieved, with the aid of patent protection, commercial production. And only after such production is there any possibility of market competition.

To this point I have taken note that the *primary* distinction between good and bad patent monopolies is that the good patent does not monopolize something the public *already has,* so as to take something away from the public. The invention covered by the good patent must be *new;* and so our statutes have always provided, though the provision was not always enforced.[10]

But beyond bare novelty one must go one further and troublesome step to have a sound system and keep the monopoly on the good side.

As we refrain from granting patents on inventions that are not new, we must also refrain from granting patents on those inventions which would arise *spontaneously,* given the need or the desire for them, as the yelp of the dog surely follows from stepping on his tail, or with *only a nominal expenditure of time, effort, money*

[10] Id. pp. 77-82, 230. Under the 1793 Act, for example, there was no examination for novelty over a period of 43 years. About 10,000 patents issued under that act for terms of 14 years, less than the number issued today in 3 months.

or wit — especially if the invention is one of real utility likely to meet with substantial or popular demand.

It was not long after the Patent Act of 1836 — in 1850 in fact — that the United States Supreme Court made this clear in the "doorknob case," *Hotchkiss* v. *Greenwood.*[11] What was involved was the trial judge's charge to a jury that if *no more ingenuity or skill was required* to construct the patented doorknob *than was possessed by an ordinary mechanic acquainted with the business,* then the patent was invalid.

The Supreme Court approved the charge. The opinion said: "In other words, the improvements is *the work of the skilled mechanic, not that of the inventor.*" (My emphasis.) The decision made clear that patents are not to be granted on inventions which are no more than what the ordinary mechanic acquainted with the business would produce as a matter of course in the pursuit of his calling. Such mechanics are *expected* to produce *new* things, such as were involved in that case, which was the attaching of an old clay doorknob to an old metal shank in precisely the same manner that metal doorknobs had been attached to such shanks before. Technically the assembly was *new,* but the court found novelty was not enough.

In referring to "mechanics" in this matter we can take them to be representative of a class — all those with *ordinary* skill in the various callings, ordinary shoemakers, ordinary chemists, electronic technicians of ordinary skill, etc.

Due to the reasoning of the case, that the new doorknob "was the work of the skillful mechanic, not that of the

[11] 52 U. S. 248.

inventor," what came out of it after 1850, and is still with us, was an injection into the law of what has ever since been called the "requirement for invention."

As is usual with a "doctrine" derived from a court opinion, the doctrine persists while the facts out of which it arose are forgotten. The opinion in the first case is quoted to the judge in a second and he does an opinion embroidering on it, his words being quoted in turn and reembroidered and so on.

I think the resulting situation with respect to the law on the "requirement for invention" was well summed up by Judge Learned Hand, who knew as much patent law as any judge ever has, at a Senate hearing in which your then Dean Colclough and I both participated in 1955, as follows:

> You could find nearly anything you liked if you went to the opinions. It was a subject on which judges loved to be rhetorical. * * * patent lawyers * * * like to quote all those things. There are lots of them.[12]

This proliferation of views on what did and did not amount to "invention" went on for 100 years. We were enlightened with the view that "invention" resulted from the exercise of the "inventive faculties" and other circular reasoning. Our standard text, Walker on Patents in its seventh or first Deller edition, said "An invention is the result of an inventive act."[13] Whole books on the patent law were written around such concepts. People collected the statements pro and con in volumes equally divided about in the middle — "invention" on one side, lack of it

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[12] Hearings pursuant to S. Res. 92, 84th Cong., 1st Sess., on the American Patent System, Oct. 10-12, 1955, p. 113.

[13] Walker on Patents, First Deller Ed., Vol. 1, p. 110. The second Deller Ed. says the same thing in Vol. 2, § 103, as would be expected of any text undertaking to reflect what the courts have said.

on the other.[13a] Negative and positive tests for detecting its presence evolved. So did exceptions to each test. And patent lawyers selectively quoted all of this mass of material as though it proved something. Judges like Learned Hand found, in his words, that "They never seemed to tend toward enlightenment." [14]

This requirement finally evolved into a "*standard* of invention" which the courts pretended was being raised and lowered like an elevator as though it were something tangible. They also proclaimed in all seriousness — and are doing so this very moment — that this "standard" was to be found in the Constitution, where there are only two words on which it could possibly be predicated, the word "inventors" and the word "discoveries." [14a] You really have to be on the Supreme Court to find a "standard" there because the only way it can work is this: if you think the lower court was wrong in sustaining the patent, you proclaim that it applied too low a standard and reverse its decision,[15] saying "*That* was not an '*invention.*' "

Some judges got it fixed in their minds that if a thing is an "invention" then it is patentable and if it is not patentable then it is not an "invention," not realizing that the same things are invented over and over — by

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[13a] For example, "Invention and the Law," by H. A. Toulmin, Jr., Prentice-Hall, Inc. 1936; Deller's Walker on Patents, 2d ed., § 126 "Cases involving Patentable Invention' and § 127 "Cases Not Involving Patentable Invention," pp. 328-402 consisting of citations only.

[14] Hearings, n. 12 supra, p. 113.

[14a] I am not unaware of the statement of the *objective* in Art. I, sec. 8, clause 8, "To promote the progress of * * * useful arts." See my "Principles of Patentability," 28 Geo. Wash. L. Rev. 393, 42 JPOS 75. When Congress exercised its power under that clause and set upon a patent system, so long as the *system as a whole* functions to further the Constitutional objective, it would not seem that the statement of the objective could set any "standard" for the patentability of any single invention.

[15] See *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 87 USPQ 303 (1950), where the two concurring opinions below were held to have applied a "standard of invention * * * that is less exacting than that required * * *."

the use of the inventive faculties or by inventive acts or what have you — and although clearly "inventions," their originators being as firmly convinced of it as was Galileo, they are not patentable for want of novelty. So it is customary for judges to approach all inventions gingerly in their opinions by referring to them as "alleged" or "supposed" inventions.

All an invention is, however, is something which has been found out, or devised, or discovered. The question today is not what to call it but whether, under the statute, it is patentable. Hundreds of "real" or "true" inventions, all resulting from "inventive acts" and the exercise of the "inventive faculties," are held unpatentable every day for lack of novelty.

The Patent Office, of course, proceeded on the same basis, and still does so to a dwindling extent, rejecting application for want of "invention" and granting them when it could be persuaded that "invention" was present. And through it all the patent lawyers and the judges persisted in telling all concerned that "invention" was something which could not be defined like God! Patent validity came as a matter of grace, from on high. This was a messy state of affairs. The surprising thing is it worked so well. But not well enough.

In 1941 a Commission, appointed by President Roosevelt, and headed by Charles F. Kettering,[16] came out with a report which said:

> One of the greatest technical weaknesses of the patent system is the lack of a definitive yardstick as to *what is invention.* To provide such a yardstick and to assure that the various courts of law and the Patent Office *shall use the same standards*, several changes

[16] For a note on who Kettering was and his prolific accomplishments in the fields of business, research and inventing, see "The Kettering Archives" by Eugene B. Jackson, 44 Jour. Pat. Office Soc. 331, May 1964.

> are suggested. It is proposed that Congress shall declare a national standard whereby [mark these words] *patentability* of *an* invention shall be determined by the objective test as to its advancement of the arts and sciences. [My emphasis.][17]

One apparent thought there was to stop talking about whether a thing is or is not an "invention," to take anything presented as *an* invention, and then to determine its *patentability* according to a standard which Congress was to declare, Congress never having said anything about it up to that time.

For some years nothing came of the Kettering Commission proposal but in the 79th, 80th, and 81st Congresses, from 1945 through 1949, identical bills were pending entitled, unfortunately but almost inevitably, "A bill to declare a national policy for determining invention." Now I have just said that the problem was not really to determine "invention," but to determine the *patentability of* inventions and this matter of language is one of major concern. Kettering got a hold on the distinction, but it keeps fading away like Alice's cat.

People don't think so much as they talk; and when they do think, they tend to think in words, at least about legal abstractions. Words are used to describe things, concepts, and experiences we have in common so that we can communicate. This thing, this concept, this experience every patent examiner, lawyer, and judge had come up against in practice was called the "requirement of invention," or just "invention" — the undefinable something or other that has to be there. This proves to be a cliché, meaningless though it is, that is hard to break away from. I taught for many years, and presumably

[17] Report of National Patent Planning Comm., June 18, 1943, H. Doc. 239, 78th Cong., pp. 6, 10.

my students learned, that the prerequisites to patentability were novelty, utility, and invention, and, of course the absence of a one-year statutory bar. There was nothing else *to* teach. Thinking and its concomitant words had not progressed beyond that point in the '30s and '40s. But today they have. Any current textbook and most cases, you will find, use the old terminology. But it isn't true any more and hasn't been for eleven and a half years — in my opinion, that is.

My not believing in ghosts or angels doesn't mean, *in law,* that there are no ghosts or angels, because if you think there are, and are frightened or informed by them, then they exist. As long as judges say there is a requirement for "invention," and many still do, then there is one. If you take a patent into court and the judge invalidates it for want of "invention" you *know* there is one. But why am I saying there is none? Am I talking theory or law; if law, then what kind of law? Or am I talking nonesense?

The outcome of those bills to determine invention, and one or two other bills, was that Congress got interested in revising and codifying the patent law and did so.[17a] In the new law (Title 35 U.S.C.) is a section, 103, described at the time by those who wrote it, at least in one place, as "incorporating a requirement for invention."[18] It was also described more carefully and accurately elsewhere[19] as providing a "*condition* which exists in our law and has existed for more than 100 years . . . by reason of decisions of the courts." (My emphasis.) And that "condition" is described in the title of this new section 103 as one for

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[17a] See Giles S. Rich, "Congressional Intent — Or, Who Wrote the Patent Act of 1952?", in *Patent Procurement and Exploitation,* BNA 1963, pp. 61-78.

[18] House Report No. 1923, 82nd Cong., 2nd Sess., to accompany H. R. 7794, p. 5.

[19] Id. p. 7.

the existence of "non-obvious subject matter." The addition of section 103 was stated in the House Report on the bill[20] to be *one of the two major changes or innovations in the statute.*

What section 103 itself says is that what is patented must *not* have been *obvious* to one of *ordinary* skill *in the art involved,* at the *time* the invention was made. The parallel with what would be expected of the "ordinary mechanic acquainted with the business" in the "doorknob case" should be clear.

This is not a "standard of invention" and it is not called a "requirement of invention." The presence or absence of "invention" is not mentioned. The use of the term "invention" was, in fact, carefully avoided with a view to making a fresh start, free of all the divergent court opinion and rhetorical pronouncements about invention."[21] And in doing that it was contemplated, as the House report states,[22] that "This section should have a stabilizing effect and minimize great departures which have appeared in some cases."

As has been pointed out by P. J. Federico, one of the drafters of that section, in his Commentary,[23] what section 103 was gunning for was

> * * * some modification * * * in the direction of moderating the extreme degrees of strictness exhibited in a number of judicial opinions over the past dozen or so years; that is, that some change of attitude more favorable to patents is hoped for. This is indicated by the language used in section 103 as well as by the general

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20 Id. p. 5.

21 The writer speaks from personal knowledge as one of the drafters.

22 Note 18, at p. 7.

23 "Commentary on the New Patent Act," by P. J. Federico, 1954, published in Vol. 1 of 35 U.S.C.A.

tenor of remarks of the Committees in the reports and particular comments.

The real vice or inadequacy of the judge-made require ment for "invention" was in the truism Mr. Federico also restated, "the so called standard of invention • • • is an unmeasurable quantity having different meanings for different persons." It left every judge practically scott-free to decide this often controlling factor according to his personal philosophy of what inventions *should* be patented, whether or not he had any competance to do so or any knowledge of the patent system as an operative socio-economic force. This was too great a freedom because it involves national policy which should be declared by Congress, not by individual judges or even groups of judges on multiple-judge courts. In section 103 Congress made such a policy declaration. It did not there declare what should constitute "invention." It was a statement of something *to take the place of* his vague concept. And it was made in the face of judicial declarations, promulgated in the *absence* of a statute, which Congress expressly desired to modify.

I would like to inject a new term into the language so we can discuss the matter rationally. I would like to call it the THIRD REQUIREMENT of patentability. The statute sets out all the requirements in as clear a form as is possible in a general statute — albeit that is a skeletonized form to which the courts must add the substance. Section 101 says inventions must be *new* and *useful*, requirement one and two; section 102 defines novelty; and section 103 lays down the *third requirement*. I repeat its clear-cut title:

"Conditions for patentability; non-obvious subject matter."

Upon examination in the Patent Office or upon adjudication in court, under the statute, when novelty, utility, and unobviousness as defined in section 103 are found to exist, and provided there is no one-year statutory bar, then there is *patentability* and *that is the end of the matter.* An examination for the presence or absence of "invention," or adherence to precedents on that muddy issue, is not called for and is not proper. It is a work of supererogation. It illustrates, furthermore, a failure to grasp the meaning of the statutory provisions. There is no such prerequisite in the statutory law.

When, as is the case with the "requirement for invention," the century's accumulation of judicial precedents range from A to Z and Congress, looking at the situation under the guiding light of Kettering's statement that *this is no yardstick and the greatest technical weakness of the patent system,* determines to make a yardstick and says the measure shall be "M", right in the middle of the alphabet, it behooves everyone concerned with administering that law to follow the measure "M" and to stop flitting about arbitrarily from A to Z lighting upon that letter which seems most appealing.

But what do we have today? A host of lawyers, examiners and judges all doing their level best to follow the law as Congress wrote it? Anything but that! What we have today is a mish-mash, and that is a nice old English term — older than the 1624 Statute of Monopolies. Why do we have a mish-mash?

First, a century of thinking and writing about a phenomenon in one set of nomenclature is a hard thing to overcome. Also a lot of people go on administering the patent laws and practicing under them without bothering to read the revision of them, so they are not aware that there has been a change.

Second, by hindsight it is apparent that those most intimately concerned with the writing and expounding of the new patent act in 1952, themselves brought up in the "requirement for invention" tradition (and I speak as one of them), did a very poor job of informing the public what it was they had done. One reason for that was that, on the average, their own comprehension of what they had done was not too clear. Remember, they were all of the school that "invention" *could not* be defined and there they were, trying to put a provision on that very subject into the statute. In going as far as seemed to be possible in that direction, they knew they were not making a *definition* but rather *a statement of policy, a specific required approach* to a difficult problem, which approach they thought would stop some of the nonsense derogatory of the patent system that had been going on. In pursuit of that objective, the drafters and Congress did at least one thing, by way of a statement of policy to counteract a judicial trend, which has had a clear-cut effect. Following a phrase casually dropped by the Supreme Court in *Cuno* v. *Automatic*,[24] in 1941, that "the new device, however useful it may be, must reveal the flash of creative genius," some courts took off on a quest for such a flash and, not finding it, invalidated patents. The last sentence of section 103 stopped this abruptly with the legislative command: "Patentability shall not be negatived by the manner in which the invention was made." But the judicial reaction to the first sentence,[25] in contrast, got to be all fouled up.

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[24] *The Cuno Engineering Corp.* v. *The Automatic Devices Corp.*, 314 U. S. 84, 51 USPQ 272 (1941).

[25] § 103. *Conditions for patentability; non-obvious subject matter*

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having oridnary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Third, the members of the bar have a lot to answer for in creating and perpetuating the mish-mash because it is they who, desiring to make use of some of the extreme cases antedating the patent act to invalidate patents in litigation, played down section 103 and early in its life persuaded a number of courts that it made no change whatever but was "mere codification." [25a] They are now paying more attention to section 103 as they learn that it can help them when they are on the other side, but they are learning slowly and my generation of lawyers, at least, is still talking, out of habit, in terms of "invention." Just listen to them!

Find me a trial lawyer for an infringer who will not urge on the court, as the existing test for "invention," the views expressed by the Justices of the Supreme Court in *A & P* v. *Supermarket,* in 1950,[26] two years before the effective date of section 103, and I will joyfully transfer my Kettering Award to him. He would deserve it more than I do. I have no clients. Herein lies a grave defect in the development of sound law through adversary proceedings.

Fourth, in the legislature the mish-mash has been described in detail, up to 1957 (the first 5 years of the act), in Senate Committee Study No. 7. What is its title? "Efforts to Establish a Statutory Standard of Invention."[27] The Senate Patent Subcommittee is still striv-

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[25a] A little reflection should show that when judicial precedents constituting the "law" range from the very liberal to the most strict, it is a patent absurdity to speak of a statute taking a middle ground as a "codification" of existing law. See note 17a, supra.

[26] Supra, n. 15, 340 U. S. 147. This was a case preeminetly in the minds of the drafters of the 1952 Patent Act, having been decided during the writing of the first drafts. See note 17a.

[27] Study of the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary, U. S. Senate, 85th Cong., 1st Sess., pursuant to S. Res. 95, Study No. 7 (1958).

ing to bring about a higher degree of uniformity in the courts in the various groups of the Patent Office, and between the two organizations, but in what terms does it do its own thinking? The subcommittee's annual Report (No. 107), April 3, 1963, is concerned about the "Patent Office 'standard of invention'" and refers to the development by that office of a "policy statement pertaining to standards of invention." The report for the next year (No. 1018), May 1, 1964, again refers to the need to eliminate differences within the Patent Office and between it and the courts "concerning the standard of invention." Meanwhile, apparently without the committee's knowledge, the Patent Office Academy has been teaching that there is no "standard of invention," that "invention" is meaningless, and that the prerequisite is as stated in section 103. Might it not do some good and help to achieve the uniformity the subcommittee so much desires if its own members, and staff, could convince themselves, in spite of what uninformed or misinformed judges have said, that the 1952 Patent Act was intended by their fellow legislators to *replace* the "standard of invention," which never was a standard, with a requirement of unobviousness to a particular kind of person at a particular time?

Amid the confusion, there are some encouraging signs in the courts. During the first few years after the 1952 act, many courts took the position that Congress really had done *nothing* in enacting section 103 and went about their old business of looking for "invention." Then in 1955 came Judge Learned Hand's *Lyon* v. *Bausch & Lomb*[28] opinion and in 1960 his *Reiner* v. *I. Leon*[29] opinion, both of which realistically appraised and appreciated what section 103 had done, namely, to restore the law

[28] *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, 106 USPQ 1 (2d Cir. 1955).

[29] *Reiner et al.* v. *I. Leon Co.*, 285 F. 2d 501, 128 USPQ 25 (2d Cir. 1960).

to what it had been 20 or 30 years earlier and, as he said, "to change the slow but steady drift of judicial decision that had been hostile to patents * * *." In the former opinion he remarked that "'invention' became perhaps the most baffling concept in the whole catalogue of judicial efforts to provide postulates for indefinitely varying occasions." In the latter he said "It is not for us [the judiciary] to decide what 'discoveries' shall 'promote the progress of sceince and the useful arts' sufficiently to grant any 'exclusive right' of [to?] inventors. Nor may we approach the interpretation of § 103 * * * with a predetermined bias." While saying "the test laid down [103] is indeed misty enough," he was able, with the evidence provided, to follow it. Certiorari was denied in both of these cases. In both cases the patents were sustained. The Supreme Court could easily have upset him had it wanted to. In fact, Judge Hand remarked to me and others at that Senate hearing in 1955[30] "Oh, they must take it," referring to *Bausch & Lomb*. Later during the hearing he testified,[31] "whether we were right in construing it [§ 103] as meaning that the old rules were to apply, remains to be seen. I hope the case will go up." From the viewpoint of the writers of the law, his *Bausch & Lomb* opinion was the first to comprehend their true intent. It has been allowed to stand.

Last April (1964) the Fourth Circuit Court of Appeals, which in 1954 said 103 merely codified the law, came to the conclusion in *Marvel* v. *Bell*,[32] after reading a number of cases which "have undertaken to comprehensively set forth the standard of invention to be used as a test," that

> When the mass of verbiage has been distilled, however, we have little more to guide us than the test which is incorporated in section 103 * * * .

[30] Supra, n. 12.
[31] Id. p. 120.
[32] 330 F. 2d 164, 141 USPQ 269.

and went in search of the "objective criteria of [un]obviousness." Perhaps, next time, that court will take the final step and *start* with the statute, ignoring the "mass of verbiage" it replaces. It seems a logical place to start, especially since it was intended to displace some of those cases in which the verbiage appears.

Last May (1964) the Sixth Circuit Court of Appeals, in *Monroe Auto Equipment Co.* v. *Heckethorn Mfg. Co.*,[33] said, "It is virtually a practical impossibility to define adequately the abstraction which we call invention,"[34] and then, in spit of that difficulty, said "we must have objective references and a place from which to start. For this we turn to the statute * * * § 103." A very good place to start! But then the court came to a very unncessary conclusion "that invention is synonymous with unobviousness. Thus to say that a device lacks invention and that it is obvious is to state the same legal proposition in two ways."[35] It

[33] 332 F. 2d 406, USPQ 553.

[34] The full quotation is (141 USPQ at 553):

> It is virtually a practical impossibility to define adequately that abstraction which we call invention. Long ago the Supreme Court said: "The truth is the word cannot be defined in such a manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is invention of a very high order. In another we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill." McClain v. Ortmayer, 141 U. S. 419, 427 [Nov. 2, 1891]. This court consistently has echoed this view. [Cases cited.]

[35] A case was cited for this proposition, *In re Jacoby, Jr.*, 309 F. 2d 513, 135 USPQ 317, 50 CCPA 734, in which the opinion was written by the present author. The Patent Office Board of Appeals had said the claimed invention "must be unobvious and involve invention." In a footnote to a reluctant but needed quotation of that statement the writer said:

> To add to the statement that it must be unobvious, as required by 35 U. S. C., 103, the further statement that it must "involve invention" is merely to state the same legal proposition in two different ways. It would seem to suffice to state it once, and that preferably, in the words of the statute.
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> It should be clear that this was intended to put the proposition, developed more forcefully in the present paper, as gently as possible and that it was *not* intended to suggest that "invention" and "unobviousness" as provided in section 103 are alternative *equivalents* for determining patentability, which they are not.

concluded that while obviousness "does not being to solve the problem," it "gives us a touchstone for the contextual meaning of invention." It also concluded that in a patent case decision is arrived at by three steps: a determination of what the prior art was, what the patentee has made, and whether it would have meen obvious, viewing the prior art from the time just prior to when the patented device was made. That is just what section 103 says! It is beginning to take hold and the next step will be to realize, what should be so clear, that when the unobviousness question has been determined, there is nothing more to do and the question of "invention" can be forgotten.[36]

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[36] Along with it can be forgotten the "complexities" of another issue wrestled with by the court in deciding whether "unobviousness" is a question of law or fact. Compare *Armour & Co.* v. *Wilson & Co.*, 274 F. 2d 143, 124 USPQ 115 (7th Cir. 1960). The presence or absence of "invention" before 1953 was always, in my judgment, the determination of an issue of public policy — what inventions *should* be patented. As such it is a "question of law." This policy has now been legislatively expressed in section 103. In that section (note 25, supra) the following potential issues of fact appear: (1) what are the *differences* between "the invention" and "the prior art"? (2) What is disclosed by the prior art presumed to have been available to the inventor? (3) What was the level of ordinary skill in the art at the time the invention was made? (4) Other fact issues relating to *circumstances* indicative of the presence or absence of obviousness, traditionally taken into account in determining "invention," such as long-felt need, immediate copying, sudden displacement of existing practices or devices, difficulty of achievement, failure of others, etc. Once these *facts* have been assembled, there remains the ultimate statutory requirement of unobviousness, the third requirement for patentability, which becomes a matter of statutory *application* and as such must be a question of law. As the court concluded in the *Armour & Co.*, case supra. "The development of the factual content necessary to statutory construction is a question of fact." It may be *several* such questions, however. As the court did *not* conclude in *Armour & Co.*, after the fact issues are settled, the determination of unobviousness is necessarily a legal conclusion arising out of the facts, pursuant to the statute — a question of law.

The *Armour* case concluded (1960), in the separate opinion devoted to the fact or law question, that after the facts were settled, "We examine the *standard of invention* applied to these facts as a question of law." (My emphasis.) But under section 103 there is no "standard of invention." The directive of the statute is to determine whether the invention "would have been obvious" on he basis of the *differences*, the *ordinary* skill, and as of the *time* of invention. *These* are the factors, and these alone, by which courts are to determine the existence of the third requirement. Leastwise, that is what the statute provides.

I cite these as straws in the wind. A study in the Columbia Law Review in 1963[37] concludes that "nothing indicates that the courts are moving toward a common interpretation of the statute." I am not so sure. I say give them time. They are stirring like live cocoons. We have only had this statute for a dozen years and the judges who have been there that long, as many of them have, are still indoctrinated with the old "standard of invention" terminology they learned from the old patent lawyers and the old textbooks. There will be new editions of all three in due course.

I might mention the Court of Customs and Patent Appeals which has been turning out a consistent stream of opinions, for as least the eight consecutive years of which I have personal knowledge, strictly applying the obviousness formula of section 103 to determine *patentability,* not the presence of invention, and slowly but surely warping the Patent Office into basing its actions on the statute. The results are beginning to show in the actions and broad opinions we review. I believe our view has invaded the Patent Office Academy. The Patent Office Solicitor's office writes its briefs in the language of the statute.

Assistant Secretary of Commerce Hollomon made a speech in New York in March, 1964, in which he is reported to have said that he "believes that the courts and the Patent Office should both follow the same standard *of patentability.*" This would be nice but is obviously impossible until one or the other of them decides to standardize. A good place to being would be the Patent Office, a lot easier than in the courts. Dr. Hollomon further said "that a standard of *patentability* should be more definitely set forth." He is to be complimented on his terminology, in not talking about

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[37] "The Standard of Patentability — Judicial Interpretation of Section 103 of the Patent Act," 63 Col. L. Rev. 306-325 (Feb. 1963).

a "standard of invention," but I think we should experiment with *using* the section 103 standard before we try to create another one. I find it very workable. It was a harder job to get it than he may imagine and in twelve years no better one has been proposed. The "criteria which may be worked out," referred to in the Revision Note to section 103, have never materialzed. I doubt they ever will.

I have had two practical suggestions in the back of my mind for some time. One is to have a sort of wall-paper border printed up to run around all the patent examiner's rooms on which the words NEW - USEFUL - UNOBVIOUS - PATENTABLE IF NO BAR are repeated endlessly. This could be designed into the proposed new Patent Office building. Most inscriptions on the present Patent Office are not very useful. They might also inscribe the Constitutional clause so people could see that it contains no *standard* for determining patentability.

The other suggestion — and this one is more serious — is based on the discovery that lecture courses are given for new and other Federal judges from time to time on how to be a judge, printed in books and given to the judges, compliments of the West Publishing Company. This Institute or some other disinterested party or organization should prepare a lecture on the basic elements of patent law in up-to-date terminology as used in Title 35 U. S. C. and see to it that the Federal judges get it. Even a glossary would help, in which it would appear that the "requirement for invention" became obsolete in 1953 by an act of Congress, along with many prior court opinions discussing it, being replaced by unobviousness as defined in 103 as the THIRD REQUIREMENT for patentability. By limiting the lecture to the terms of the statute and their clear meanings I do not see how the bar could object and many judges would be grateful.

I was recently discussing this subject with a young patent lawyer, urging that we should all stop talking about the "standard of invention." She said, "What difference does it make?" That is a fair question which has to be answered, and with my present answers I will end:

The differences it will make — the reasons why we *must* learn to make this change — are these, among others:

- Until we stop talking about a "requirement for invention," it will never be clear that THE THIRD REQUIREMENT is that stated in section 103 *and no other;* that when 103 has been complied with, there is no further and different requirement called "invention"; that compliance with 103 is the policy judgment of Congress on how to bring the invention within the Constitutional purpose.

- Because looking for the presence of "invention" in addition to compliance with 103 defeats the legislative purpose.

- Because talking about both unobviousness and "invention" as different things leads to weird and confused thinking.

- Because testing patentability by the presence of "invention" gives judges and the Patent Office too much freedom to decide patentability of new and useful inventions on the basis of a personal view as to what *should* be patentable, instead of accepting the view of the legislature on that question of national policy.

- Because it will get all those concerned with the administration of the patent system — Patent Office, Courts, and the bar — speaking the same language, a sine qua non to the communication of intelligence.

- Because you cannot use "invention" as both an abstract noun and a concrete noun in the same statute or opinion without confusion. The invention is the thing that has been produced by the "inventor." There will be muddy thought as long as one has to say: this invention (in the concrete sense) is unpatentable because it is not an invention (in the abstract sense).
- Because it will do more than anything else I can think of to bring about that long-sought-for greater uniformity of opinion on patentability.
- Because it makes the prerequisities to patentability intelligible.

As I hope I have been.

To quote Learned Hand — that well-named judge — once more, maybe I am only "shoveling smoke." Time alone will tell.